

**REMARKS**

Applicants have carefully considered the Office Action dated April 7, 2004 regarding the above-identified application, and the amendments above together with the remarks that follow are presented in a bona fide effort to respond thereto and address all issues raised in that Action. Independent claims 1 and 11 are amended to address the art rejections set forth in the Action by more clearly reciting subject matter that is patentable over the applied art. Dependent claims 7 and 8 are amended to conform to the amended form of independent claim 1. Claim 9 has been cancelled, in view of the limitations added to parent claim 1. Claims 10 and 13-19 have been cancelled to reduce issues. Claim 20 has been added to recite an additional distinctive feature of the interface, in the series of claims relating to the clock itself. As discussed more below, it is believed that remaining claims 1-8, 11, 12 and 20 are allowable. Applicants respectfully request reconsideration and prompt issuance of a notice of allowance of this application.

Applicants filed information disclosure statements (IDSs) in this case, on January 18, 2001 and July 22, 2002. The Office Action included a copy of the document citation form (PTO-1449) from the July 22, 2002 IDS with initials indicating consideration of the three documents listed on that form. However, the Action did not include a similarly initialed copy of the of the document citation form (PTO- 1449) from the January 18, 2001 IDS. It is respectfully requested that the Examiner consider all of the documents cited in the January 18, 2001 first IDS, as part of the reconsideration of this application, and that the Examiner indicate consideration by initialing the form from that IDS and returning it with the next Official communication regarding this case.

The issues raised in the Office Action relate to patentability over the art. The rejections are summarized below, after which a detailed explanation is given as to how the amended claims patentably distinguish over the applied art.

**The Rejections**

Claims 1- 4, 9-16, 18 and 19 were rejected under 35 U.S.C. § 102(e) as anticipated by US. patent no. 6,671,291 to Soliman. The Soliman patent discloses a Qualcomm technique for synchronizing system time and frequency at a 'child' base station to those of a 'parent' base station (abstract). The child station includes a so-called "mobile station" fixed to and co-located with the respective base station, although the so-called mobile station is not a fully functional station in that it is fixed and it only receives forward link signals (column 4, lines 39-46), for timing/frequency setting purposes. The mobile station forms a time/frequency transfer unit which receives and demodulates the system time and frequency values from the parent base station and generates corrected system time and frequency values by adjusting a clock and the center frequency of a pilot signal. The mobile station directly communicates the corrected system time and frequency values to the child base station to remove time and frequency discrepancies. The rejection apparently is based on a contention that this arrangement of Soliman satisfies the original limitations of the listed claims.

Claims 5 and 17 were rejected under 35 U.S.C. § 103 as unpatentable over Soliman in combination with U.S. Patent No. 5,511,067 to Miller. The Examiner relies on Miller only for use of a sync message to acquire a paging channel.

Claims 6-8 were rejected under 35 U.S.C. § 103 as unpatentable over Soliman in combination with the prior art described on page one of Applicants' own specification. The rejection identifies the discussion of a resettable automobile clock, in the background section of this application, and alleges that it would have been obvious to apply Soliman's system to set a clock in a car.

**Patentability**

The art rejections summarized above are respectfully traversed. For reasons discussed below, it is believed that all of the claims now pending in this application (claims 1-8, 11, 12 and 20) patentably distinguish over the applied art.

Claim 1 has been amended to state that the mobile station provides two-way voice telephone communication. The so-called “mobile station” in the Soliman system is no longer really “mobile,” because it is fixed to a fixed base station so as to provide timing information to the base station. Further, the “mobile station” of Soliman is not really a mobile **telephone** station, in that it only receives forward link signals (column 4, lines 39-46), for timing/frequency setting purposes. Hence, the allegedly “mobile” station in Soliman does not provide two-way voice telephone communications, as now required by claim 1.

Claim 1 also has been amended to more clearly state that the clock is an external device coupled to the mobile station (as opposed to a clock functionality built into many mobile stations). The external clock itself includes a display, for output of the current time that the processor maintains from the clock’s oscillator. The clock processor periodically obtains a local time computed by the mobile station and uses the local time to update the current time in the external clock, that is to say, so as to update the time that is output to the user via the display. The Soliman system is really setting a system clock for a base station. The base station system clock of Soliman does not provide a clock time display to a user or an update to such a time, as now claimed.

Since the Soliman patent does not meet all the limitations of independent claim 1, that claim and the claims that depend from it are not anticipated by the Soliman patent. Hence, the anticipation rejection of claims 1-4 should be withdrawn.

The additional teaching added from Miller, i.e. the use of a sync message to acquire a paging channel, made to allege obviousness of claim 5, does not make up for the absences of several claim limitations of parent claim 1 from the teachings of Soliman. It is respectfully submitted that the proposed combination of Soliman and Miller still would not satisfy the requirements for a mobile station, that the mobile station provides two-way voice telephone communications and that the resettable clock provides a display of time to a user. Since the combination does not meet the limitations of claim 5 incorporated from claim 1, the rejection of claim 5 should be withdrawn.

Claims 6-8 also should be patentable over Soliman either alone or in combination with the prior art knowledge of manually resettable dashboard clocks. The admitted prior art (Applicants' specification page 1) provides only a general statement that resettable dashboard clocks were known. The known setting techniques for these prior art clocks, however, are manual, not automatic. There is no teaching or suggestion, other than Applicants' disclosure and claims, which would lead one of skill in the art to so modify the Soliman system as to use that system to reset the time of a dashboard clock (instead of the base station system clock of Soliman). It is respectfully submitted that claims 6-8 specify subject matter that is patentable (non-obvious) over Soliman and the admitted prior art. Hence, the obviousness rejection of those claims also should be withdrawn.

Independent claim 11 relates to a resettable clock, per se. As amended, the clock provides time information to a user, and the clock now specifically includes a display for outputting the current time to the user. The clock that is reset in the Soliman system is a system clock of a base station. It does not provide time information to a user, and it does not include a display for outputting the current time to the user. Hence, Soliman does not anticipate claim 11 (or dependent claims 12 and 20) and the anticipation rejection of claim 11 should be withdrawn.

It is submitted that the secondary teachings cited in the 103 rejections (Miller and the admitted prior art) do not make up for the deficiencies in the teachings of Soliman, with regard to claims 11, 12 and 20. For example, Miller relates to layered channel software, ostensibly for a base station. Miller, particularly in the part applied in the rejection, does not disclose a resettable clock with a user display function.

The admitted prior art knowledge of resettable clocks, would provide a teaching of a display to a user. However, in such clocks, the reset functions have been entirely manual in nature. There is no teaching in Soliman or in the discussion of the prior (page 1 of the present specification) as to how or why one of skill in the art would modify the known clock to provide an interface to a CDMA receiver or to configure a processor to obtain an indication of local time from such a receiver for updating the clock time. Hence, one of skill in the art aware of Soliman and the known resettable clocks discussed on page 1 of this application would not have found it obvious to modify or combine Soliman and the prior art clocks so as to produce a clock that satisfies all of the language of amended claim 11.

For at least these reasons, it is respectfully submitted that amended claim 11 patentably distinguishes over all of the art applied to reject original claims in the Office Action. Claims 11, 12 and 20 therefore should be in condition for allowance.

It is believed that new claim 20 specifies an additional patentable distinction. The claim states that the interface is configured to receive the indication of the local time from a CDMA compatible wireless mobile telephone station serving as the CDMA network compatible receiver. The applied art does not disclose or fairly suggest a clock interface that is compatible with a wireless mobile telephone station. Soliman utilizes hardware from a station that was mobile, but it is no longer mobile when coupled to the base station. Also, the mobile station in Soliman would not provide "telephone" service in that it only receives forward signals for timing and

does not communicate telephone information in both directions as required by a telephone conversation. Hence, Soliman would not meet the interface requirement of claim 20, and the proposed combinations would similarly fail as each combination is based on Soliman for an alleged disclosure of an interface.

### **Conclusions**

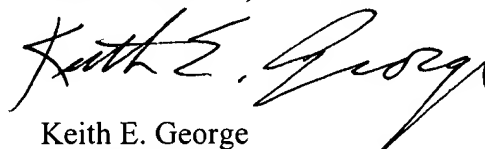
Upon entry of the above claim amendments, claims 1-8, 11, 12 and 20 should be active in this application, and all of those should be in condition for allowance. Accordingly, this case should now be ready to pass to issue; and Applicants respectfully request a prompt favorable reconsideration of this matter.

It is believed that this response addresses all issues raised in the April 7, 2004 Office Action. However, if any further issue should arise that may be addressed in an interview or obviated by an Examiner's amendment, it is requested that the Examiner telephone Applicants representative at the number shown below.

To the extent necessary, if any, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Keith E. George  
Registration No. 34,111

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8603 KEG:apr  
Facsimile: (202) 756-8087  
**Date: July 7, 2004**